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Attorney Docket No. YOR920000220US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): F. Hendriks et al.
Docket No.: YOR920000220US1
Serial No.: 09/642,531
Filing Date: August 18, 2000
Group: 2132
Examiner: Benjamin E. Lanier

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature: 

Date: June 29, 2005

Title: Methods and Apparatus for Associating a User with
Content in a Collaborative Whiteboard System

TRANSMITTAL OF REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

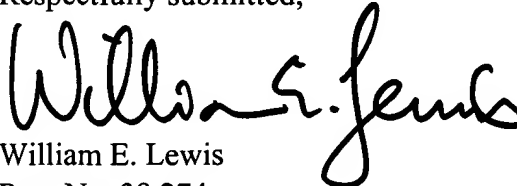
Sir:

Submitted herewith is the following document relating to the above-identified patent application:

(1) Reply Brief.

It is believed that there is no additional fee due in conjunction with the response. In the event of any non-payment or improper payment of a required fee, the Commissioner is hereby authorized to charge or to credit **International Business Machines Corporation Deposit Account No. 50-0510** as required to correct the error.

Respectfully submitted,



Date: June 29, 2005

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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

Applicants (hereinafter referred to as "Appellants") submit this Reply Brief under 37 C.F.R. §1.193(b)(1) in response to the Examiner's Answer mailed on April 29, 2005 relating to the Appeal Brief filed by Applicants on February 24, 2005 appealing the final rejection of claims 1-23 of the above-identified application.

ARGUMENT

In the Examiner's Answer, the Examiner reiterates that: claims 3 and 13 stand rejected under 35 U.S.C. §101; claims 1, 4-9, 11 and 14-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,577,120 to Penzias (hereinafter "Penzias"); and claims 2, 10 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Penzias in view of U.S. Patent No. 4,993,068 to Piosenka et al. (hereinafter "Piosenka").

It appears that the Examiner's Answer primarily repeats the same grounds of rejection that were presented in the final Office Action dated September 27, 2004. These grounds of rejection

were addressed in Appellants' Appeal Brief. Appellants therefore re-allege herein and incorporate by reference the arguments presented in their Appeal Brief in their entirety.

In addition, the Examiner's Answer appears to present further arguments in support of such rejections. Appellants will address below these further arguments offered in the Examiner's Answer and further point out the deficiencies in the rejections and the cited references.

In the Examiner's Answer on pages 2 and 3, for each individual ground of rejection, it is asserted that Appellants' brief "does not include a statement that [each] grouping of claims does not stand or fall together and reasons in support thereof . . . [s]ee 37 C.F.R. §1.192(c)(7)." This is correct, since such a statement is no longer required under the modifications to the appeal process rules as specified in the Official Gazette dated September 7, 2004 (the Appeal Brief was filed subsequent to the rule change). More particularly, in comment (9) to section 41.37, it is stated that "[t]he grouping of claims requirement set forth in former Rule 192(c)(7) is removed." Thus, Applicants believe that they properly address the grounds of rejections and individual claims in their Argument section, as is now required.

In the Examiner's Answer on pages 6 and 7, the Examiner asserts that Applicants fail to claim or disclose an "essential teaching of registration, or equivalent process." First, Applicants do not consider any such registration process a "missing essential element" of the claims. Claims 3 and 13 describe a method and an apparatus, respectively, "wherein the one or more identifiers are assigned to the one or more users before the data units are entered by the one or more users." Applicants believe that such dependent claim language properly stands alone without a need to refer to a registration process.

While some form of an initial identification set-up process may be performed to assign identifiers to the one or more users, the registration step mentioned by the Examiner is no more "patentably essential" to claim 3 and 13 than the requirement that the collaborative computing devices be turned on or powered-up before use. As far as support in the specification, firstly, an originally-filed claim may be relied upon as disclosure. Nonetheless, as illustratively described in the present specification at page 7, lines 14-17, "[t]he identification process for each user at a given location may be performed during an off-line set-up session prior to the collaboration session, or in real-time during the course of the on-line collaboration session with other collaborative computers."

In the Examiner's Answer on page 7, it is asserted that "the Examiner can find no teaching in the claim language or any definition of the word collaborate to insinuate the collaboration must occur between human beings." Applicants argued in their Appeal Brief that one difference between the claims and Penzias is that the claims relate to a "distributed collaborative computing system" such as "a collaborative whiteboard system" (Specification, p. 3, lines 2-4), while the reference relates to a system for identifying individuals who have engaged in a retail transaction. One of ordinary skill in the art will recognize that these systems perform different functions and are, therefore, not identical.

The present specification at page 2, lines 5-11, state: "A collaborative whiteboard system is a distributed computing system which includes two or more individual electronic whiteboard systems, as mentioned above, in communication with each other while running a collaborative application. While the individual systems, and thus their respective users, are remote from one another, a user at a first location is able to view information written by a user at a second location. This way, the remote users may interact as if they are in the same location." (Underlining added for emphasis).

Further, independent claim 1 recites: "a distributed collaborative computing system with two or more collaborative computing devices coupled via a communication network and respectively executing a collaborative application thereon, the method comprising the steps of: associating one or more identifiers with data units respectively entered by one or more users of at least one of the two or more collaborative computing devices" (Underlining added for emphasis).

Applicants contend that they are not arguing limitations that are not in the claims, as asserted by the Examiner. But rather, Applicants are arguing that the present specification and claims are quite clear with respect to what is meant by a "distributed collaborative computing system," a meaning that is significantly distinct from the system disclosed in Penzias. Further, the Examiner is not permitted to interpret a claim term to have a meaning that is repugnant to its well-known meaning.

In the Examiner's Answer on page 7, it is asserted that when a "user presses their finger down on a pad [of a fingerprint scanning device], it actuates an acquisition phase for the device to capture the fingerprint sample" and that this "actuation of the pad would meet the limitation of a

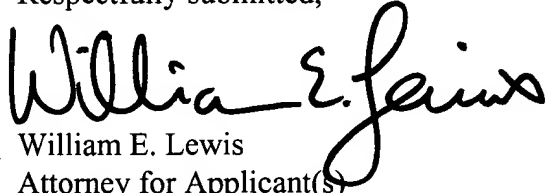
‘user selectable switch.’” First, Appellants point out that claim 21 does not recite a “user selectable switch,” but rather a “user settable switch.” The full text of the claim recites that “the user identification means includes a user settable switch associated with an input device for permitting the user to enter a unique identifiable code.” Appellants assert that the fingerprint scanning device referred to by the Examiner has no means of permitting the user to set an ID code. That is, the fingerprint scanning device automatically reads the user’s fingerprint. There is no user settable choice in the matter. One example of a “user settable switch” is described in the present specification at page 11, lines 27 and 28, namely, dual-in-line (DIP) switch 207 shown in FIG. 2. Penzias is silent to any such feature.

In the Examiner’s Answer on page 8, it is stated that “Penzias meets the limitation of claim 22 because [sic] have a smart card interface with a point of sale terminal to distribute information [sic] is clearly an interconnection of information technology devices within the range of an individual person.” However, this completely ignores the meaning of the claim language “personal area network” or PAN. Page 13 of the present specification describes the well-known meaning of a PAN. Again, the Examiner is not permitted to interpret a claim term to have a meaning that is repugnant to its well-known meaning.

Lastly, in the Examiner’s Answer on page 9, additional statements are made to support the combination of Penzias and Piosenka. However, none of these statements resolve the deficiency of the combination. Namely, as stated in Appellants’ Brief, there is no showing of objective evidence of record that would motivate one skilled in the art to combine Penzias and Piosenka. Whether or not Penzias discloses that “a user can enter identification information in the form of height, weight, . . . in order to purchase a certain product,” and whether or not Piosenka discloses “a personal identification system wherein the biometric terminal accepts signatures,” the issue is whether sufficient objective evidence is put forth that would motivate a combination of the two systems. Nothing the Examiner stated directly addresses what parts of the references actually provide the motivation to be combined with each other. Instead, as before, the statements provided in the Examiner’s Answer are precisely the type of subjective, conclusory statements that the Federal Circuit has indicated provides insufficient support for an obviousness rejection.

For at least the reasons given above and those set out in the Appeal Brief, Appellants respectfully request withdrawal of the §101, §102(b) and §103(a) rejections of claims 1-23.

Respectfully submitted,

A handwritten signature in black ink that reads "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent.

Date: June 29, 2005

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